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EXAMINER

NGUYEN, LE V

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2174

21

DATE MAILED: 05/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/478,006

Applicant(s)

GOURDOL ET AL.

Examiner

Le Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3,8,13,16-24,27-30,41,42,44-46,48-50,52 and 56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3,8,13, 27-29 and 56 is/are allowed.
- 6) ☒ Claim(s) 16-24,30,41,42,44-46,48-50 and 52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### DETAILED ACTION

1. This communication is responsive to Amendment D, filed 3/1/04.
2. Claims 3, 8, 13, 16-24, 27-30, 41, 42, 44-46, 48-50, 52 and 56 are pending in this application. Claims 3, 8, 13, 16, 19, 22, 27, 30, 41, 42, 44-46, 48-50, 52 and 56 are independent claims; claims 1-2, 4-7, 9-12, 14-15, 25-26, 31-40, 43-47, 51 and 53-55 have been cancelled; claims 3, 8, 13, 28 and 29 have been amended; and, claims 3, 8, 13, 27-29 and 56 are allowed. This action is made Final.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### *Claim Rejections - 35 USC § 103*

4. Claims 1, 4 – 6, 9, 10, 14 – 16, 30, 32, 33, 37 – 40, and 53 – 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nowlan (US 6,169,538) and Kinoe et al. (US 6,469,722).

#### **Claim 1, 6, 11, and 16:**

Nowlan discloses a method for varying the size of a plurality of icon images displayed in a display device based upon a preference value (col. 5, lines 23 – 30). Nowlan teaches a software program that requires a computer readable medium. Nowlan teaches selecting icons that are enlarged (col. 5, lines 23 – 30). This selection process includes selecting individual icons to perform variable icon sizing. Nowlan teaches generating icon images of different respective size, wherein the different sizes of the icon images are based upon said user

preference value (col. 5, lines 23 – 30). Nowlan teaches displaying said different sized icon images (col. 5, lines 23 – 30). The different and respective size consists of only two sizes, a larger size and a smaller size. Nowlan teaches a method for detecting the selecting of individual icons (fig. 8). Nowlan teaches storing icons representative of a plurality of icon images, receiving a user command to display icons of varied sizes in said window, displaying said icons with different relative sizes within said window (fig. 8). The enlarged icons are a selection of smaller icons that are being considered seriously by the user. Individual icons must be selected before achieving the step of enlargement. The figure further demonstrates generating icon images of different respective sizes, wherein the different sizes of the icon images are based upon said user preference value (fig. 8).

While Nowlan teaches displaying images using two distinct sizes, Nowlan fails to teach storing of icon data representative of varying the size of icon images or of “respective sizes” as cited by the Applicant including various sizes between the two distinct sizes. Kinoe teaches generating icon images of different respective sizes, wherein the different sizes of the icons images are based upon user preference values (col. 3, lines 44 – 50). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine generating icon images of different respective sizes, wherein the different sizes of the icons images are based upon user preference values taught by Kinoe with the enlarging of icons images disclosed by Nowlan. Doing so enables users to determine which icons to give extra prominence.

**Claim 4, 9 and 14:**

Nowlan demonstrates images of different respective sizes located within a window (fig. 8).

**Claim 5, 10, and 15:**

Nowlan demonstrates retrieving said icon image data from memory and scaling said icon image data in preparation for display on said display device (fig. 8). The enlarge icons associated with alphanumeric characters are examples of icon image data from memory that is displayed on a display device. All images must be processed inside a memory before being displayed on any output device.

**Claim 30:**

Nowlan teaches storing icons representative of a plurality of icon images, receiving a user command to display icons of varied sizes in said window and displaying said icons with different relative sizes within said window (fig. 8).

While Nowlan teaches displaying images using two distinct sizes, Nowlan fails to teach storing of icon data representative of varying the size of icon images or of “respective sizes” as cited by the Applicant including various sizes between the two distinct sizes. Kinoe teaches different size icons being based upon characteristics of objects represented by the icons (col. 3, lines 44 – 50). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine generating icon images of different respective sizes, wherein the different sizes of the icons images are based upon user preference values taught by Kinoe with the enlarging of icon images disclosed by Nowlan. Doing so enables users to determine which icons to give additional prominence.

**Claim 32:**

Nowlan teaches different sizes of said icons are based upon a user preference value given to each of said icons (fig. 8).

**Claim 33, 37, and 39:**

Nowlan and Kinoe teach the rationale of claims 33, 37, and 39 in rejected claim 16.

**Claims 34, 38, and 40:**

Nowlan teaches different sized icon images located within a window (fig. 8).

**Claim 35 and 36:**

Nowlan teaches designating a step comprising the indication of relative size of selected icons (fig. 8). When the user selects a certain icon, the icons in the designated area are increased in relative and absolute size.

**Claims 53, 54, and 55:**

Kinoe teaches a designated user preference value being different for each of the selected icons (col. 3, lines 44 – 50).

5. Claims 2, 7, 12, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nowlan (US 6,169,538) and Kinoe et al. (US 6,469,722) as applied to claims 1, 6, 11, and 16 above, and further in view of Grossman et al. (5,564,004).

**Claims 2, 7 and 12:**

Nowlan and Kinoe fail to teach sorting icon images into an order based upon said designated preference values. Grossman teaches sorting icon images into an order based upon said designated preference values (col. 2, lines 40 – 50). The increase of use giving an icon greater prominence is a method for sorting. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine sorting icon images into an order based upon said designated preference values taught by Grossman with the icons sizing disclosed by

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Kinoe and Nowlan. Doing so provides an automated determination of icons that are determined to have greater prominence.

**Claim 17:**

Nowlan and Kinoe fail to teach sorting of icon images into an order based up on said object characteristic. Grossman demonstrates sorting of icon images into an order based up on said object characteristic (fig. 7 – 8). The formula for determining likeliness is a method for sorting. This is sorting icon images into an order based upon said object characteristic. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine sorting of icon images into an order based up on said object characteristic taught by Grossman with the icons sizing disclosed by Kinoe and Nowlan. Doing so provides a method for giving icons determined to be more important greater prominence.

**Claim 18:**

Grossman teaches determining size of icon by associating a maximum sized icon image with an object having one extreme value for the object characteristic (fig. 7 – 8). Icons that are less likely to be used are either made smaller or merged with other icons automatically. Icons less likely to be used are associated with a minimum sized icon image with an object having another extreme value for the object characteristic. Further, growing and shrinking icons based on likeliness of use involves assigning sizes to the remainder of said icons images with objects, in proportion to the objects associated with the maximum and minimum sized icons.

6. Claims 19, 22, 41, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nowlan (US 6,169,538) and Kinoe et al. (US 6,469,722) as applied to claims 1, 6, 11, and 16 above, and further in view of Mernyk et al. (US 6,496,206).

**Claim 19 and 22:**

Nowlan discloses a method for varying the size of a plurality of icon images displayed in a display device based upon a preference value (col. 5, lines 23 – 30). Nowlan teaches a software program that requires a computer readable medium. Nowlan teaches selecting icons that are enlarged (col. 5, lines 23 – 30). This selection process includes selecting individual icons to perform variable icon sizing. Nowlan teaches generating icon images of different respective size, wherein the different sizes of the icon images are based upon said user preference value (col. 5, lines 23 – 30). Nowlan teaches displaying said different sized icon images (col. 5, lines 23 – 30). The different and respective size consists of only two sizes, a larger size and a smaller size. Nowlan teaches a method for detecting the selecting of individual icons (fig. 8). Nowlan teaches storing icons representative of a plurality of icon images, receiving a user command to display icons of varied sizes in said window, displaying said icons with different relative sizes within said window (fig. 8). The enlarged icons are a selection of smaller icons that are being considered seriously by the user. Individual icons must be selected before achieving the step of enlargement. The figure further demonstrates generating icon images of different respective sizes, wherein the different sizes of the icon images are based upon said user preference value (fig. 8).

While Nowlan teaches displaying images using two distinct sizes, Nowlan fails to teach storing of icon data representative of varying the size of icon images or of “respective sizes” as cited by the Applicant including various sizes between the two distinct sizes. Kinoe teaches generating icon images of different respective sizes, wherein the different sizes of the icons images are based upon user preference values (col. 3, lines 44 – 50). It would have been obvious



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to one with ordinary skill in the art at the time of the invention to combine generating icon images of different respective sizes, wherein the different sizes of the icons images are based upon user preference values taught by Kinoe with the enlarging of icons images disclosed by Nowlan. Doing so enables users to determine which icons to give additional prominence.

Nowlan and Kinoe fail to teach an object characteristic that is a number of files in the object. Mernyk teach proving an object characteristic that is a number of files in the object (fig. 1). The window object includes a number representing the number of files within the said window object. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine display of a number of files on the main object with generating icon images of different respective sizes, wherein the different sizes of the icons images are based upon user preference values with the enlarging of icons images disclosed by Nowlan and Kinoe. Doing so informs the user regarding the number of potential files stored within a particular main object area.

**Claim 41 and 49:**

Nowlan, Kinoe, and Mernyk disclose the rationale for claims 41, 45, and 49 in rejected claims 19 and 22. Nowlan teaches software that requires a method, apparatus, and a computer readable medium (abstract). Nowlan Kinoe, and Mernyk do suggest data regarding the size, amount of memory used, number of files used, or any type of measure of how recently an object was added. Such information is useful to those who are responsible for performing maintenance and evaluating performance of computing equipment.

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7. Claims 20, 21, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nowlan (US 6,169,538), Kinoe et al. (US 6,469,722), and Mernyk et al. (US 6,496,206) as applied to claims 19 and 22 above, and further in view of Grossman et al. (US 5,564,004).

**Claim 20 and 23:**

Nowlan, Kinoe, and Mernyk fail to teach sorting of icon images into an order based up on said object characteristic. Grossman demonstrates sorting of icon images into an order based up on said object characteristic (fig. 7 – 8). The formula for determining likeliness is a method for sorting. This is sorting icon images into an order based upon said object characteristic. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine sorting of icon images into an order based up on said object characteristic taught by Grossman with the icons sizing disclosed by Kinoe and Nowlan. Doing so provides a method for giving icons determined to be more important greater prominence.

**Claim 21 and 24:**

Grossman teaches determining size of icon by associating a maximum sized icon image with an object having one extreme value for the object characteristic (fig. 7 – 8). Icons that are less likely to be used are either made smaller or merged with other icons automatically. Icons less likely to be used are associated with a minimum sized icon image with an object having another extreme value for the object characteristic. Further, growing and shrinking icons based on likeliness of use involves assigning sizes to the remainder of said icons images with objects, in proportion to the objects associated with the maximum and minimum sized icons.

8. Claims 42, 44, 45, 48, 49, 50 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nowlan (US 6,169,538), Kinoe et al. (US 6,469,722), Mernyk et al. (US 6,496,206) and *Windows 95 Uncut* by Alan Simpson.

Nowlan, Kinoe, and Mernyk disclose the rationale for claims 42, 44, 48, 49, 50 and 52 in rejected claims 19 and 22. Nowlan teaches software that requires a method, apparatus, and a computer readable medium (abstract).

While Nowlan, Kinoe, and Mernyk do not disclose outputting data regarding the size, amount of memory used, number of files used, or any type of measure of how recently an object was added. Nowlan does suggest outputting data regarding the size, amount of memory used, number of files used, or any type of measure of how recently an object was added by teaching providing a selectable memory and info item on the toolbar (fig. 3).

**Claim 42, 44, and 50:**

Windows 95 teaches software that requires a method, apparatus, and a computer readable medium (p. 401). Windows 95 teaches an object characteristic being the amount of memory that the object uses (p. 401). The file items within the list represent objects that include the amount of memory they use. It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the object characteristic being amount of memory that the object uses taught by Windows 95 with the storing and resizing of icons representative of a plurality of icon images disclosed by Grossman and Nowlan. Doing so allows users to access and view internal information related to the objects corresponding with the said icons.

**Claim 45:**

Windows 95 teaches software that requires a method, apparatus, and a computer readable medium (p. 401). Windows 95 teaches an object characteristic being the number of files in the object (p. 401). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine the number of files in the object taught by Windows 95 with the storing and resizing of icons representative of a plurality of icon images disclosed by Grossman and Nowlan. Doing so allows users to access and view internal information related to the objects corresponding with the said icons.

**Claim 46, 48, and 52:**

Windows 95 teaches software that requires a method, apparatus, and a computer readable medium (p. 401). Windows 95 teaches an object characteristic containing a date. This date is interpreted as being an object characteristic that measures how recently the object was added or amended (p. 401). It would have been obvious to one with ordinary skill in the art at the time of the invention to combine an object characteristic containing a date taught by Windows 95 with the storing and resizing of icons representative of a plurality of icon images disclosed by Grossman and Nowlan. Doing so allows users to access and view internal information related to the objects corresponding with the said icons.

***Response to Arguments***

9. Applicant's arguments filed in Amendment D have been fully considered but they are not persuasive.

Applicant argued the following:

(a) Kinoe fails to disclose or suggest that different sizes of icons are based upon characteristics of objects represented by the icons.

(b) Mernyk fails to disclose or suggest that the size of the window icon is based on the number of files within the window.

(c) With the benefit of hindsight, the examiner appears to establish a) that Windows 95 Uncut fails to disclose or suggest using such an object characteristic as a basis for sizing an icon of the object, and b) that Nowlan, Kinoe, Mernyk disclose or suggest basing the size of an object's icon on an amount of memory that the object uses, a size of the object or how recently an object was added or amended.

(d) Although references can be combined or modified, the assertion that if an object has a characteristic, then it would have been obvious to modify another characteristic such as sizing of the icon, in reference to claims 19, 22, 41 and 49, without any suggestion of the desirability of such a combination does not render the resultant combination *prima facie* obvious neither does the combination of Nowlan, Kinow, Mernyk and Windows 95 Uncut render the resultant combination obvious to one of ordinary skills in the art in claims 42, 44-46, 48-50 and 52.

The examiner disagrees for the following reasons:

Per (a), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Nowlan teaches storing icons representative of a plurality of icon images, receiving a user command to display icons of varied sizes in said window and displaying said icons with different relative sizes within said window

(fig. 8). The teaching extracted from Kinoe is for the feature of variable size icons being based upon characteristics of objects represented by the icons (col. 3, lines 44 – 50).

Per (b), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Nowlan discloses a method for varying the size of a plurality of icon images displayed in a display device based upon a preference value (col. 5, lines 23 – 30) and selecting icons that are enlarged (col. 5, lines 23 – 30), which includes selecting individual icons to perform variable icon sizing. Moreover, Nowlan teaches generating icon images of different respective size, wherein the different sizes of the icon images are based upon user preference value, displaying said different sized icon images and receiving a user command to display icons of varied sizes in said window wherein different sizes of the icon images are based upon the user preference value (col. 5, lines 23 – 30; fig. 8). The teaching extracted from Kinoe is for generating icon images of different respective sizes wherein the different sizes of the icons images are based upon user preference values (col. 3, lines 44 – 50), while the teaching extracted from Mernyk is for the feature wherein an object characteristic is a number of files in the object (figs. 1-4; col. 1, lines 40-60; col. 3, line 64 through col. 4, line 9; *a characteristic of a folder is a number of files in the folder*).

Per (c), in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the

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time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Per (d), in response to applicant's argument that such a combination does not render the resultant combination *prima facie* obvious, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The teachings of the modified Mernyk, as applied to claims 19, 22, 41 and 49, is made generally available to one of ordinary skill in the art and would have suggested that an object having a characteristic be modifiable to include another characteristic such as sizing of the icon so that users may view the number of potential files stored within a particular main object area at a glance. Furthermore, the teachings of the modified Mernyk, as applied to claims 42, 44-46, 48-50 and 52, would have suggested outputting data regarding the size, amount of memory used, number of files used or type of measure of how recently an object was added, to one of ordinary skill in the art, in order to allow users to access and view internal information related to objects corresponding with the respective icons.

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Inquires*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lê whose telephone number is (703) 305-7601. The examiner can normally be reached on Monday - Friday from 5:30 am to 2:00 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid, can be reached on (703) 308-0640.

The fax numbers for the organization where this application or proceeding is assigned are as follows:

(703) 872-9306 [Official Communication]

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

LVN  
Patent Examiner  
April 23, 2004

*Kristine Kincaid*  
KRISTINE KINCAID  
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